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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

DEC 13 2006

GROUP 1700

Application Number: 10/684,787
Filing Date: October 14, 2003
Appellant(s): DALMAIS ET AL.

Susan Luna
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 21, 2006 appealing from the Office action mailed May 19, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct. All pending claims are rejected.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

It is noted that the appeal brief contains a "Grouping of Claims" section. Said section is not required under the rules of practice before the Board of Patent Appeal and

Interferences effective September 23, 2004 but is not considered grounds for a "Notice of Defective Appeal Brief" because the amended rules do not prohibit said section. In the "Grouping of Claims" section, Appellant argues claims 21 and 22 do not stand and fall together. This is consistent with appellant's arguments in the "Arguments" section of the brief.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,352,507	BRESSON et al	10-1994
4,766,811	LINSKA	08-1988
WO 93/01003	PINKSTON	01-1993

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 2, 4-9, 21, and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bresson et al (US 5,352,507) in view of Linska (US 4,766,811) and WO93/01003 (herein referred to as Pinkston).

Bresson teaches a multi-layered sleeve-like printing blanket that is mounted on gapless cylinders or tubular blanket carrier. The printing blanket comprises a seamless outer printing surface layer, at least one reinforced elastomer layer, and a resiliently compressible layer (abstract). The elastomer layer is reinforced by fibers substantially parallel with the inward and outward sides of the cylindrical tube ((col 5, lines 43+). Said layers are applied to a metal carrier with a thickness of greater than 0.001cm (col

8, lines 53+). As shown in FIGURE 6, the compressible layer (4) is positioned between the base layer (not shown) and the surface layer (6), and the reinforcing ply (5) is positioned between the compressible layer (4) and the surface layer (6). With regard to claim 5, the laminate further comprises a second reinforced elastomer (4b) between the surface layer and the compressible layer (FIG 6 and col 8, lines 25+). The carrier layer is mounted to a metal cylinder using an optional layer of suitable adhesive (col 5, lines 53+). Said adhesive may be a urethane adhesive (col 10, lines 59+) or other suitable pressure sensitive adhesive. Said layer of adhesive is understood to extend over substantially the entire surface of the base ply (see FIG 3, reference no 3 and col 11, lines 15+).

Bresson does not teach that the urethane adhesive layer may comprise a corrosion-inhibiting additive. However, Linska teaches a method of applying a printing blanket to a printing cylinder, which is designed to prevent corrosion of the cylinder surface. The method utilizes a double-side coated adhesive foil applied to the printing blanket. The adhesive-coated printing blanket is then wrapped about the cylinder so that the printing blanket is adhered to the cylinder by the double-side coated adhesive foil (abstract). The adhesive comprises a foil coated on both sides with a homogeneous adhesive layer (col 2, lines 46+). Said method is a cheap, easy manner in which to supply the metal cylinder with corrosion resistance (col 8, lines 18+). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the adhesive coated foil taught in Linska in place of the adhesive layer taught in Bresson. The motivation for doing so would have been to increase the corrosion resistance of the metal cylinder.

Linska does not teach the foil layer can be replaced by a polymeric layer comprising metal particles. However, Pinkston (like Linska) teaches an alternative for the nickel and chrome plating traditionally provided on printing cylinders in order to provide said cylinder with corrosion protection (top of page 2). Pinkston teaches corrosion resistance can lent to the cylinder by providing a sacrificial metal layer over the cylinder (page 4, lines 18+). The sacrificial metal may comprise a metal foil or utilizing metal particles in a polymeric binder (page 5, lines 20+). The courts have held that it is obvious to substitute one composition for a second composition when the equivalency of the compositions is recognized in the prior art (see MPEP 2141.05). Furthermore, an express suggestion to substitute one equivalent component for another is not necessary to render such substitution obvious. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a polymer layer comprising metal particles in place of the metal foil taught in Linska. The motivation for doing so would have been that said layers are known to be equivalent for providing corrosion resistance to printing cylinders. Linska teaches the particles have a diameter of 1-50um (page 6, line 3), which means the film is at least 0.0013cm thick.

With regard to claim 22, the metal carrier is herein understood to read on the claimed "base ply," the surface layer is understood to read on the claimed "surface layer," the metal particle containing layer is understood to read on the claimed "polymer in the form of a film or sheet" and the adhesive between the base layer and the foil is understood to read on the adhesive that adheres the second surface of the base ply and the "polymer in the form of a film or sheet."

(10) Response to Argument

Appellant's arguments have been fully considered but they are not persuasive.

Appellant argues Bresson does not teach or suggest a protective polymeric film for use on the surface of the metal base ply of a printing blanket construction. Appellant further argues there is no teaching or suggestion that "optional" adhesive(3) of Bresson would function as a protective polymer film for the purpose of reducing corrosion and abrasion of printing blankets and cylinders. Said arguments are noted but are not persuasive because Bresson was never relied upon for such teachings. Rather, the examiner relied upon the combination of Bresson, Linska, and Pinkston to teach the claimed printing blanket comprising the protective polymeric film. In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, since the printing blanket rendered obvious by Bresson in view of Linska and Pinkston is structurally identical to the claimed printing blanket, it is understood to inherently reduce corrosion and abrasion of printing blankets and cylinders.

According to Appellant, the metal carrier layer taught in Bresson is separate from the blanket construction and it not part of said blanket. The examiner respectfully disagrees. The blanket is applied to the carrier and subsequently applied to the printing cylinder (see column 9, lines 1-60). Thus, the carrier is taught to be part of the blanket construction prior to application to the printing cylinder.

Appellant argues the skilled artisan would not have been motivated to use the adhesive foil of Linska in as the adhesive layer of Bresson's printing blanket because Linska applies the adhesive foil between a cover plate and a printing cylinder, as opposed to between a printing blanket and a printing cylinder. Appellant argues that there is not teaching that the cover plate of Linska functions as a printing plate. The examiner takes the position no such teaching is required for the combination to be proper. The examiner takes the position that the skilled artisan would have been motivated to combine the teachings of Linska and Bresson because they are in the same field of endeavor (the adhesion of covers onto printing cylinders) and the problem addressed in Linska (the reduce corrosion of the print cylinder) is reasonably pertinent to the invention of Bresson. While the examiner concedes Bresson is silent to concerns of corrosion, said concerns are well established in the art of printing cylinders (see Linska and Pinkston). Thus, the skilled artisan would have been motivated to utilize the adhesive foil of Linska as the adhesive taught in Bresson in order to reduce the corrosion of the printing cylinder and metal base layer.

The examiner concedes Linska does not contain an explicit teaching that the outer adhesive layers of the adhesive foil function as protective polymer layers. However, the examiner has taken the position that any polymeric layer inherently functions as a protective layer. Appellant has not presented any argument or evidence to the contrary. Therefore, the position is maintained.

Appellant further argues the laminate of Linska does not teach or suggest a multi-layer laminate comprising two or more polymers with a polymer film therebetween. The examiner notes the rejection never relied upon Linska for such a teaching. Rather, the claimed protective polymeric film is rendered obvious by substituting the corrosion-inhibiting layer of Pinkston in place of the foil taught in Linska. In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant argues there is not motivation for making the proposed substitution of the particle-containing layer taught in Pinkston for the foil taught in Linska. Specifically, Appellant argues that Pinkston is not directed to a protective film which is used to reduce corrosion and abrasion of a printing blanket having a metal base ply but is rather concerned with reducing corrosion of a blanket cylinder. Said argument is noted, but is not persuasive. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessarily that the prior art suggest the combination to achieve the same advantage or result discovered by appellant. In the present application, it would have been obvious to the skilled artisan to replace the corrosion-inhibiting foil layer of Linska (which protects the blanket cylinder from corrosion) with a functionally equivalent corrosion-inhibiting layer taught in Pinkston. The courts have acknowledged that "functional equivalence" is sufficient motivation to combine references. While the motivation suggested by the prior art is not the same as appellant's motivation of reducing the corrosion and abrasion of the printing blanket, it is not required to be. Furthermore, it is noted that the benefits obtained by appellant are not unexpected.

With respect to claim 22, appellant argues that even if all the proposed substitutions were made, the claims would still not be met as the substitution of Linska's adhesive coated foil and the elastomer/metal particle layer of Pinkston for the adhesive taught in Bresson would not constitute a protective polymer film adhered to the second surface of a metal base ply with an adhesive as claimed. The examiner respectfully disagrees for the reasons noted above. Specifically, the proposed combination of reference would result in a printing blanket comprising a metal base ply, an adhesive directly adjacent to the base ply, a metal particle containing polymeric protective layer adjacent the adhesive layer, and a second adhesive layer adjacent the protective layer on the side opposite the first adhesive layer. Such an embodiment reads on the claimed invention.

With respect to the claimed thickness, appellant argues that Pinkston teaches grinding the coating containing the particle to expose the metal particles in the coating. Appellant does not refute the examiner's position that there is nothing in Pinkston that suggests the particles themselves are ground. Thus, the particle-containing layer will have a thickness at least as thick as the particles. The particles are taught to have a diameter of 1-50um, which is sufficient to read on the claimed thickness of "at least 0.0013cm" which is equivalent to thicknesses greater than 1.3um.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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